REMARKS

Reconsideration of the above-identified application, in view of the following remarks, is respectfully requested. Claims 20-40 are pending and at issue.

Obviousness-Type Double Patenting Rejection

Claims 20-40 have been provisionally rejected for obviousness-type double patenting over claims 36-46 of U.S. Patent Application No. 10/468,685, claims 20-34 of U.S. Patent Application No. 10/644,587, and claims 20 and 22-37 of U.S. Patent Application No. 10/644,588, in view of applicant's allegedly admitted prior art.

Applicants respectfully request that these provisional rejections be held in abeyance because none of the patent applications containing the conflicting claims have been allowed or issued as patents.

Rejections Under 35 U.S.C. §103(a)

Claims 20-40 have been rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 4,943,590 ("the '590 patent") in view of the present specification.

Applicants respectfully traverse this rejection, and request reconsideration.

As acknowledged by the Examiner, the '590 patent does not "disclose ... the patient population that consists of those who failed to respond to initial treatment with a selective serotonin reuptake inhibitor other than escitalopram" (page 4, penultimate paragraph, February 7, 2006 Office Action). The '590 patent also does not teach or suggest that escitalopram (as opposed to any other treatment) could effectively treat depression in the presently claimed patient population.

The Examiner cites the third paragraph of page 1 of the present specification which discloses that clinical studies on depression indicate that non-response or resistance to SSRIs is substantial. *See* Specification at p. 1, lines 17-19. According to the Examiner, it would have been obvious for one of ordinary skill in the art to administer escitalopram to a patient who failed to respond to another SSRI in order to optimize the treatment of depression.

The cited portion of the specification indicates the problem of treating patients who are non-responsive or resistant to treatment with SSRIs, but provides no suggestion that it was previously known to use escitalopram to treat depression in this patient population.

Furthermore, to establish obviousness, there must be a reasonable expectation of success when combining or modifying the references. *See Brown & Williamson Tobacco Corp. v. Phillip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000); *Life Techs., Inc. v. Clontech Labs., Inc.*, 224 F.3d 1320 (Fed. Cir. 2000) (stating that prior art references can only render a claim obvious where the combination of their teachings provides a reasonable expectation of success). *See also* MPEP §2142. Here, the '590 patent and the cited portion of the specification would not have provided one of ordinary skill in the art with a reasonable expectation of success for administering escitalopram to treat depression in patients who failed to respond to initial treatment with a different SSRI. Rather, one of ordinary skill would have been discouraged from using escitalopram to treat these patients because, by definition, they would have already failed to respond to an SSRI. Thus, one of ordinary skill would have had no motivation to use another SSRI after a similar treatment had previously proven unsuccessful.

For the foregoing reasons, Boegesoe (either alone or in combination with the cited portion of the specification) fails to render obvious claims 20-40. Therefore, applicants respectfully request withdrawal of this rejection.

Conclusion

In view of the above remarks, applicants believe that each of the pending claims in this application is in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

By Dianna Goldenson

Dianna Goldenson
Registration No.: 52,949
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(212) 527-7700
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant